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### REMARKS

The Applicant notes with appreciation the Examiner's thorough review of the application, as evidenced by the Office Action.

The Applicant acknowledges the withdrawal of the previous rejections under Section 102(b) based on U.S. Patent 5,829,832 issued to *Molee, et al.*

#### New Claims

Claims 1-28 are not amended. The Applicant submits new claims 29-33, which recite a labeling system including a container.

#### Claim Rejections – 35 U.S.C. § 103(a)

Office Action, ¶ 2. The Examiner rejected claims 1, 10-13, 16, and 23-26 under Section 103(a) as being obvious and unpatentable over the U.S. Patent 5,829,832 issued to *Molee, et al.* This rejection is based on *Molee* alone.

MPEP § 2142: *Molee* does not teach or suggest all the features of the claimed invention. A *prima facie* case of obviousness requires that the cited prior art reference teaches or suggests all the features of the claimed invention. MPEP § 2142; *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of non-obviousness.” MPEP § 2142; *In re Geiger*, 815 F.2d 686, 690 (Fed. Cir. 1987).

There is no teaching or suggestion in *Molee* of the following features, among others, as recited in independent claims 1, 16, and 29:

1. “a . . . writing surface”
2. “a generally planar writing surface”
3. “for receiving temporary . . . indicia”
4. “such that a majority of said writing surface extends beyond said edge”
5. other features, as recited.

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In contrast to the generally planar surface in the claims, *Molee* only teaches the placement of an exterior surface (28) on a cylindrical cushion or support structure (12) "for advertising purposes." (*Molee*, col. 3, lines 10-21). *Molee* does not teach or suggest the use of temporary indicia. Accordingly, *Molee* does not teach or suggest a writing surface.

*Molee* also does not teach or suggest a structure wherein "a majority of said writing surface extends beyond said edge" upon which the structure is mounted. In contrast to the claimed invention where the writing surface is beyond the edge, the exterior surface described and illustrated in *Molee* is positioned centrally, around the top edge of a chair. More specifically, the exterior surface (28) extends almost completely around a generally cylindrical structure having a core or longitudinal aperture (24) which is placed around "the top tubular frame portion (16) of a lawn/beach chair (18), while holding a draped towel (20) in place." (*Molee*, Abstract, Figure 2, 4-5; col. 3, lines 10-31).

Because *Molee* does not teach or suggest all the features of the claimed invention, the rejection does not meet the initial burden of stating a *prima facie* case of obviousness and it should be withdrawn.

MPEP § 2143.01: If the *Molee* structure were modified as suggested by the Examiner, the modifications would render *Molee* inoperable for its intended purpose. As stated in MPEP Section 2143.01:

If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

*In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). MPEP § 2143.01.

*Generally Planar Writing Surface*: Modifying *Molee* to include a generally planar surface instead of the rounded and generally cylindrical exterior surface (28) described would render the *Molee* apparatus inoperable because the supporting structure (12) is a head rest,

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designed so “the head/neck of the person can rest comfortably on the supporting structure (12).” (*Molee*, Abstract). A generally planar surface would not operate as a comfortable head rest.

*Temporary Indicia*: Modifying *Molee* to include temporary indicia would render the apparatus inoperable for several reasons. First, the temporary indicia (intended to advertise) would be quickly obscured and/or erased during normal use because the *Molee* apparatus is a head rest. (*Molee*, Abstract). Resting one’s head on the temporary indicia would obscure and/or erase it. On the opposing side or top of the structure, any temporary indicia would also be quickly obscured and/or erased during normal use because the structure (12) is sized and shaped to be grasped directly on the exterior surface when using the structure to retain a towel. Grasping the temporary indicia with one or two hands would quickly obscure and/or erase it, thereby making the *Molee* apparatus inoperable for its intended purpose.

*Majority of Surface Beyond the Edge*: Modifying *Molee* so that, when in use, a majority of the exterior surface (28) extended beyond the top frame of the chair would render the apparatus inoperable because the *Molee* structure would not be in position to grasp or retain a draped towel (20) in place on the chair. (See *Molee*, Abstract, Figure 2, 4-5; col. 3, lines 10-31). Positioning the *Molee* structure so that a majority of the exterior surface would extend beyond the top edge of the frame of the chair would render *Molee* inoperable for its intended purpose.

*As a Whole*: If the *Molee* structure were modified as suggested by the Examiner to perform the features and functions of the claimed invention, such modifications would render *Molee* inoperable for its intended purpose.

Because the suggested modifications would render the sole reference inoperable for its intended purpose, the rejection is unsupported by the cited art and should be withdrawn.

MPEP § 2144.04(I): The generally planar writing surface recited in independent claims 1, 16, and 29 is not merely a matter of design choice, nor is it ornamental.

The Examiner cites *In re Seid* in support of the position that providing a generally planar writing surface is “entirely a matter of design choice.” (Office Action, ¶ 4). The applicant in

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*In re Seid* argued that limitations in the shape of a human figure adapted to cover the neck of a bottle patentably distinguished the claimed invention. 73 U.S.P.Q. 431 (C.C.P.A. 1947). The court found that matters relating to ornamentation only, which have no mechanical function, cannot be relied upon to distinguish a structural claim.

The applicant is not relying on any ornamentation to distinguish the claims from the prior art. As discussed above, a generally planar writing surface is not taught or suggested by *Molee*. Moreover, although *Molee* suggests nothing about temporary indicia, any person attempting to write legible text on a cylindrical cushion like the one described in *Molee* would disagree with the suggestion that providing a generally planar writing surface was merely ornamental or that "the surface of *Molee et al.* would perform equally well." (Office Action, ¶ 4). For the reasons discussed above, and because the writing surface is not merely ornamental, the rejection should be withdrawn.

Office Action, ¶ 8. The Examiner again rejected claims 4-7 and 20-22, under Section 103(a), on the grounds that the invention as claimed is obvious in light of *Molee, et al.*, in view of the U.S. Patent 5,581,921 issued to *Hutchens*.

¶ 10. The Examiner again rejected claims 14 and 27, under Section 103(a), on the grounds that the invention as claimed is obvious in light of *Molee, et al.*, in view of the U.S. Patent 5,384,999 issued to *Roche, et al.*

¶ 13. The Examiner rejected claims 2, 15, 17 and 28, under Section 103(a), on the grounds that the invention as claimed is obvious in light of *Molee, et al.*, in view of the U.S. Patent 5,727,818 issued to *Schmeida*.

All the claims depend from independent claims 1 or 16. The independent claims recite patentable subject matter, including features that are not taught or suggested by the cited references. Neither *Molee* alone, nor in combination with any other reference, teaches or suggests all the features of independent claims 1 or 16. Accordingly, the features recited in the claims depending therefrom are patentable and allowable.

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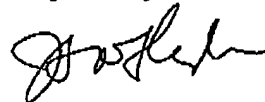
### CONCLUSION

After entry of the requested amendment, claims 1, 2, 4-7, 10-17, and 20-33 are pending in the application. In light of this amendment and the remarks presented, the Applicant respectfully submits that all the claims of the application are patentable.

The undersigned is available at (404) 881-7821 if the Examiner has any questions or requests that may be resolved by telephone in order to expedite the examination.

The Applicant submits herewith a Fee Transmittal listing the amounts due for Excess Claims (\$125), a Request for Continued Examination (RCE) (\$395), and a Petition and Fee for Extension of Time (\$510). The Applicant does not believe any request for extension of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. In the event, however, that additional extensions of time are necessary to allow the consideration of this paper, such extensions are hereby petitioned-for under 37 CFR § 1.136(a) and any fee required therefor (including fees for net addition of claims) is hereby authorized to be charged to my credit card, in accordance with the Credit Card Payment Form submitted herewith.

Respectfully submitted,



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#### CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this paper is being transmitted by facsimile to (571) 273-8300 at the U.S. Patent and Trademark Office on this Tuesday, the twenty-seventh (27) day of December, 2005.

  
J. Scott Anderson